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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,750	02/14/2001	Michael R. Miller	150-123CIP04	2171

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EXAMINER

CHOI, PETER H

ART UNIT PAPER NUMBER

3623

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/783,750	<b>Applicant(s)</b> MILLER ET AL.	
	<b>Examiner</b> Peter Choi	<b>Art Unit</b> 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 2/14/01.

2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-18 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-18 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All    b) ☐ Some \* c) ☐ None of:  
     1. ☐ Certified copies of the priority documents have been received.  
     2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior non-provisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process. The claimed invention is not within the technological arts – i.e., no computer implementation or any other technology is employed.

Software, programming, instructions, or code not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in a computer system. When such descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases.

Furthermore, software, programming, instructions, or code not claimed as being computer executable are not statutory because they are not capable of causing functional change in a computer system. In contrast, when a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer and the program, and the computer is capable of executing the program, allowing the program's functionality to be realized, the program will be statutory.

In the present case, none of the recited steps in claims 1-18 are directed to anything in the technological arts as explained above with the exception of the recitation that the method is computerized. Looking at the claims as a whole, nothing the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps. Claims 1-18 are deemed to be directed to non-statutory subject matter where there is no indication that the proposed database serves any function other than data storage. The claims 7-18 merely recite descriptive material (software) per se, but do not disclose a computer readable medium or capability of execution by a computer. Therefore, the preambles of claim 7 and 13 are taken to merely recite a field of use. To overcome this rejection, the examiner suggests that the applicant incorporate into claims 7-18 language that the proposed software is recorded on a computer-readable medium and is capable of being executed by a computer. The examiner also suggests

that the applicant incorporate into claims 1-18 language that the proposed database serves a function other than data storage.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, regarding claims 1-6, the claimed invention collects user requests for information (i.e., repeatable) used in presenting information to users and conducting an analysis on user interest on certain products (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-18 are deemed to be directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Day et al. (U.S Patent # 2001/0013011A1).

As per claim 1, Day et al. teaches a method for test marketing in real time based on user polls, comprising the steps of:

(c) presenting information (a customized customer offer list using an offer communicator) relating to the at least one product to the selected users; [Claim 1]

(d) receiving feedback (customer purchase information indicative of items being purchased) from the users; [Claim 1] and

(e) analyzing the feedback (generating a report) for determining user interest (effectiveness of special offers) in the at least one product. [Claim 24]

Regarding Claim 1a and 1b, Day et al. is silent regarding using a database for storing and searching user input relating to a product. However, Day teaches a method where databases are used to store customer account information and a list of special offers to customers. Customers use a kiosk to request information regarding products in a store. Customers can use the kiosk to lookup the price of a product [Paragraph 78] or can present a customer account card to access a list of special offers customized for that customer [Paragraph 43]. It is old and well known in the art that usage of a customer account card can be tracked by documenting purchase history and the items scanned at the kiosk, information that can also be stored on a database. The storage of such information on computer databases enables the store to search the database for particular products queried by users and aids in developing effective special offers for customers. Therefore, it would have been obvious to one of ordinary skill in the art at

the time of invention to combine the teachings of Day et al. with additional databases for the reasons discussed therein above.

Since the teachings of Day et al. consist of special offers on specific items to the customer, the decision to purchase these items has been interpreted by the examiner to be feedback. If the customer decides to purchase one of the items, then the special offer was positively received. Since the store can compare the record of a customer's purchase history and the special offers they receive, that information can also be construed as feedback.

As per claim 2, Day et al. teaches a method as recited in claim 1, wherein the user input includes submissions (scans) of representations of bar codes (UPC) associated with products. [Paragraph 80]

As per claim 4, Day et al. teaches a method as recited in claim 1, wherein the information presented to the users includes a promotional offer (customized list of special offers) [Paragraph 43].

As per claims 5 and 6, Day et al. is silent regarding the level of analysis conducted on user feedback. Day et al. discloses a statistical analysis of customer behavior [Paragraph 57], specifically, period-based statistics per household [Paragraph 183]. However, geographical analysis and time period-based analysis are nonfunctional



descriptive material. The nature of the analysis does not alter functionality. Also note that it is old and well known in the art to evaluate effectiveness by a number of demographics, including age, gender, geographic location, time of year, etc.

4. Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Day et al. as applied to claims 1-2 and 4-6 above, and further in view of Plainfield et al (U.S Patent #5,893,075)

As per claim 3, Day et al. fails to teach a survey that is to be used with an information station. However, Plainfield et al. teaches a marketing method where users are prompted to participate in a marketing survey. Plainfield et al. teaches a method wherein the information presented to the users includes a poll (list of selected questions in multiple formats {yes/no, true/false, multiple choice, etc} seeking information on quality or service, opinions, preferences, etc.). [Column 4, lines 15-20]

The information gathered from the user surveys could be used to make the information station more effective. User survey information could be used in conjunction with available demographic data to aid the store in developing special offers that are more attractive to customers. User survey information could also be used to improve the use of the information station (in terms of user interfaces, presentation of information, and ease of use). It would have been obvious to one of ordinary skill in the art at the

time of invention to combine the teachings of Day et al. with a user survey for the reasons discussed therein above.

Claims 7-18 are rejected under the same rationale as claims 1-6.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tedesco et al. (U.S Patent #6,161,059) teaches a method of conducting marketing promotions and participating in surveys while making a purchase at a point-of-transaction. User responses are stored in a customer response database, enabling product manufacturers and machine operators to evaluate the effectiveness of a marketing promotion and to obtain information about customer preferences or opinions.

Jheeta (U.S Patent #5,619,558) teaches a method of marketing through an automated teller machine (ATM). The customer is encouraged to participate in a telephonic survey by a specified reward or bonus. Marketing messages specific to each customer are generated based on stored customer profiles and their answers to survey questions.

Larry Riggs' "Direct Marketing Goes Electronic" discloses the use of computer terminals to obtain information and demonstration on products. Riggs also discloses the customer use of shopping kiosks to display products compatible to data entered about themselves.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Choi whose telephone number is (703) 305-0852. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PC  
December 21, 2004

  
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